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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|------------------------|---------------------|------------------|
| 09/666,725 | 09/20/2000 | Richard B. Himmelstein | HIM-PT009.1 | 6238 |

3624 7590 02/12/2003

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EXAMINER

BACKER, FIRMIN

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------|-------------------------|--|
| Office Action Summary | Application N . | Applicant(s) | |
| | 09/666,725 | HIMMELSTEIN, RICHARD B. | |
| | Examiner | Art Unit | |
| | Firmin Backer | 3621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.

- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.

- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 20 September 2000.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 20 September 2000 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is in response to a letter for patent filed on September 20th, 2000 in which claim 1 is presented for examination. Claim 1 is pending in the letter.

Claim Objections

1. Claim 1 is objected to because of the following informalities: Applicant discloses “*the internet*” in paragraph 7 line 1. Applicant is advised to delete the word “*the*” in order to overcome Examiner’s objection Appropriate correction is required.
2. Claim 1 is objected to because of the following informalities: Applicant discloses “*such a*” in paragraph 4 line 5. Applicant is advised to delete the word “*such*” in order to overcome Examiner’s objection Appropriate correction is required.

Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefore ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The

filling of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claim 1 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of copending Application No. 09/921,534. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Minton (U.S. PG Pub 2002/0091611 A1).

7. As per claim 1, Minton teaches a bartering system for implementing barter between a plurality of parties each having one or more classes of items available for barter (*data processing system (20) for allowing individual to buy and sell securities*) (*see fig 1, 2, 3, page paragraph 0014*) comprising means (*server, 316*) for creating a barter order (*buys and sell orders*) (*fig 3, page 4 paragraph 0053*) including means for designating a selected quantity (*quantity*) of a first class of items (*securities*) to be bartered (*to be traded*) (*fig 3, page 4 paragraph 0053*), means for

designating a date range (*time*) for transferring title (*transmitting title*) of the selected quantity (*quantity of securities*) of the first class of items to be bartered whereby a barterer may elect to defer the transfer of title to the first class items to a time after the barter order is used to complete a barter transaction or elect to transfer title (*transmitting title*) along with the completion of such barter transaction (*see abstract, page 2 paragraph 0016, claim 16*), means for designating a barter value (*the price*) of the first class of items to be bartered (*fig 3, page 4 paragraph 0053*), and means for designating a second class of items (*securities*) to be acquired (*bought*) (*fig 3, page 4 paragraph 0053*) means for posting (*displaying order*) barter orders (*order to buy and sell*) via the internet (*public network*) to a barter database (*see figs 1, 3 page 4 paragraph 0055, 0056*), means for displaying (*display 96*) via the internet posted barter orders whose first class of items match the second class of items of a barterer's order (*see page 4 paragraph 0056*), and means for selecting (*matching and executing*) a posted barter order from the displaying means to effectuate a barter transaction which combines a barterer's barter order with the selected posted order (*paragraph 0057, 0069*).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. *Hawkins et al (6,247,000) teach method of matching a plurality of predetermined financial transactions for a plurality of users, wherein data for the plurality of predetermined financial transactions.*

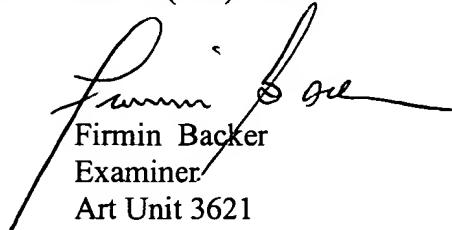
b. *Hawkins et al (U.S. Patent No. 6,029,146) teach a system and method for direct broker to broker trading that will automatically match an investor's security order with an executing broker's match confirmation and will automatically generate and route via the SWIFT Financial Network a settlement instruction to the investor's clearing agent.*

c. *Minton (U.S. Patent No. 6,014,643) teach a data processing system, and a network of data processing systems for allowing individuals to buy and sell securities directly from other individuals, with only minimal oversight by a broker.*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Firmin Backer
Examiner
Art Unit 3621